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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,402	06/12/2000	TETSUNORI FUJISAWA	2000_0562A	7196

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EXAMINER

FREDMAN, JEFFREY NORMAN

ART UNIT PAPER NUMBER

1637

DATE MAILED: 12/16/2002

114

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/581,402

Applicant(s)

FUJISAWA ET AL.

Examiner

Jeffrey Fredman

Art Unit

1637

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 November 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on 27 November 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 2-7, 12 and 13.

Claim(s) withdrawn from consideration: 8-11, 14 and 15.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Jeffrey Fredman
Primary Examiner
Art Unit: 1637

Continuation of 2. NOTE: The new amendment, to add claim 16, while narrowing in some respects, significantly alters the scope of the claims and requires further search and consideration. In particular, the amendment significantly redefines R9, and these changes would require further search and consideration, and do not place the application in better form for appeal. .

Continuation of 5. does NOT place the application in condition for allowance because: Applicant argues that the claims, as amended, are now fully enabled. First, since the amendment was not entered, the arguments as directed against the claims are not persuasive. Second, the citation of the Chemical Reviews article is not timely, since under 1.195, evidence must be submitted prior to appeal for consideration. Third, a cursory review of the exhibit shows that it is post filing date art, since the application has priority back to 1997. The entirety of the Chemical Reviews article was not provided so the examiner cannot fully analyze this reference. However, the cited portions indicate that the replacements in some regions, such as P1 (which correlates to R3 of the claim) are unpredictable, noting at page 2754, column 2, that replacements at P1 resulted in loss of inhibitory activity, other replacements were unstable, and other modifications led to a loss of potency. Even the P3 modification has unpredictable effects, such as the replaced by B-amino group is indicated to have a 10-50 fold loss of activity (see page 2755, column 2). So the cited portions of the Chemical Reviews reference supports a finding of unpredictability, not predictability. (As a side point, Applicant correctly notes that claim 15 is withdrawn).